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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,647	11/07/2001	Bernd Mayer	IN-5505	7382

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

09/889,647

MAYER ET AL.

Examiner

Art Unit

Patrick D. Niland

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 is/are allowed.
- 6) ☒ Claim(s) 2-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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1. The amendment of 10/11/02 has been entered. Claims 1-23 are pending.
2. Claims 2-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
  - A. The instant claims 3, 4, 5, 6, 7, 8, 9, 10 depend from claim 1 ultimately. These claims are directed towards "coating compositions" whereas claim 1 is directed towards a "system of at least four components for a coating composition". The claim dependency makes it unclear as to whether the instant claims 3-9 require the claimed components to be in mixed or unmixed form.
  - B. The instant claims 11-13 refer to the "coating composition of claim 1". Claim 1 is directed towards a "system of at least four components for a coating composition". It is therefore unclear to what coating composition claims 11-13 refer.
  - C. The instantly claimed component III requires the water to be substantially free of acrylate copolymers. However, acrylate copolymers may be one of the composition ingredients and the instant claims are directed to the composition which is a mixture of the claimed ingredients. It is therefore unclear how or if "substantially free from acrylate copolymers" limits the instant claims. This continues to be unclear in claims 3-13.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-23 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/42247

Lettmann et al. as interpreted by US Pat. No. 6025031 Lettmann et al..

Lettmann et al. discloses the instantly claimed coating composition, methods of making the composition, and coatings made therefrom. See the entire document. As stated above, it is not seen that the recitation excluding acrylate copolymer of component III distinguishes over the prior art since a composition is claimed and the composition requires acrylate copolymer. It is further expected that at some point the water of the prior art did not contain acrylate copolymer.

Reference to the instant claim 1 is not persuasive since the rejected claims are directed to coating compositions and coatings made therewith. It is therefore the examiner's position that the components are mixed together in the instantly claimed coating compositions. The prior art therefore continues to read on these claims. Also, as previously stated, the water is expected to have existed without polyacrylate at some point in the processing. Therefore claim 2 continues to be encompassed by the prior art.

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6. Claims 2-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/42247 Lettmann et al. as interpreted by US Pat. No. 6025031 Lettmann et al..

Lettmann et al. discloses the instantly claimed coating composition, methods of making the composition, and coatings made therefrom. See the entire document. As stated above, it is not seen that the recitation excluding acrylate copolymer of component III distinguishes over the prior art since a composition is claimed and the composition requires acrylate copolymer. It is further expected that at some point the water of the prior art did not contain acrylate copolymer. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients in the compositions, methods of making, and coatings of Lettmann et al. because they are encompassed by the prior art and would have been expected to give compositions having the properties disclosed by Lettmann et al.. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to add pure water to the composition discussed above to thin it as is evident from the art recognized term "thinner". Reference to the instant claim 1 is not persuasive since the rejected claims are directed to coating compositions and coatings made therewith. It is therefore the examiner's position that the components are mixed together in the instantly claimed coating compositions. The prior art therefore continues to read on these claims. Also, as previously stated, the water is expected to have existed without polyacrylate at some point in the processing. Therefore claim 2 continues to be encompassed by the prior art.

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7. Claim 1 is allowable over the cited prior art because the prior art does not disclose a system of the claimed components.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (703) 308-3510. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

May 4, 2003

  
Patrick Niland  
Primary Examiner  
Art Unit 1714